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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,109	09/12/2003	Marioara Mendelovici	1662/56403	6486

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KENYON & KENYON
One Broadway
New York, NY 10004

EXAMINER

SHAMEEM, GOLAM M

ART UNIT PAPER NUMBER

1626

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,109

Applicant(s)

MENDELOVICI ET AL.

Examiner

Golam M. M. Shameem, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10,20,22 and 24-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,20,22 and 24-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/12/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

This application is a divisional of 10/090,710 03/04/2002 which claims benefit for domestic priority under 35 U.S.C. § 119(e) [to a provisional application 60/273,172 03/02/2001], is acknowledged.

Status of Claims

Claims 1-10, 20, 22 and 24-34 are currently pending in the application.

Receipt is acknowledged of Applicant's amendment / response filed on April 03, 2006 and that has been entered.

Claims 20 and 22 have been amended. Claims 24-34 have been added. Claims 11-19, 21 and 23 have been canceled.

Information Disclosure Statement

Receipt is acknowledged of Information Disclosure Statement (IDS), filed on 09/12/2003, which has been entered in the file.

Response to Election/Restriction

In response to the restriction requirement, Applicants have elected Group II, which includes claims 20 and 22 drawn to a process for preparing 1,2-benzisoxazole-3-methane sulfonamide with traverse is acknowledged. Applicant's arguments [to withdraw the restriction requirements between the Groups I and II] have been fully considered and found persuasive and Examiner has agreed to rejoin and examine Groups I and II together (including the newly added claims 24-34) because they fall within the same scope of invention and therefore, Applicants arguments are rendered moot in view of the present Office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10, 20, 22 and 24-34 are rejected under 35 U.S.C. § 102(b) as being anticipated by Giannella *et al* (1971). Applicant claims process for the preparation of 1,2-benzisoxazole -3-acetic acid and its derivatives thereof. Giannella *et al* also disclose the synthesis procedures for several substituted 1,2-benzisoxazole acid derivatives and at least one of them anticipates the instantly claimed invention wherein the reaction is carried out between 4-hydroxycoumarins and hydroxylamine in the presence of a base. [Please see column 1, lines 3-4 and CHART 1, page 397; also EXPERIMENTAL (10), page 401, a copy is provided with this Office action] which reads on the instantly claimed process.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claim in the subject matter, which the applicant regards as his invention.

Claims 20, 22 and 24-34 are rejected under 35 USC § 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 20, 22 and 24-34 are rejected as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The process leading to the step of “converting” [found in claim 20, line 5] to produce

1,2-benzisoxazole-3-methane sulfonamide is not recited in the claims. The omission of failing to describe the claimed invention renders the claim incomplete. This claims are written in functional language and therefore, broader than the enabling disclosure also. The claims should recite specific steps and reagents as to how one of ordinary skill in the art would perform the "converting" step to obtain the desired final product in order to overcome the rejection or to amend the claims with in the context and scope of the claims.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone number for this Group is 571-273-8300.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet

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e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.



GOLAM M. M. SHAMEEM, PH.D
PRIMARY EXAMINER

Golam M M Shameem, Ph.D.
Primary Examiner
Art Unit 1626,
Technology Center 1600

April 24, 2006